

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jeffrey A. Tilton et al.

Attorney Docket No.: 25363A

Serial No.: 10/789,143

Group Art Unit: 1794

Filed: February 27, 2004

Examiner: Piziali, Andrew T.

For: LAYERED POLYMER FIBER INSULATION AND
METHOD OF MAKING THEREOF

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

Appellant presents this Reply Brief in response to the Examiner's Answer ("Answer") mailed April 16, 2010. The Answer withdraws certain of the longstanding rejections addressed in the Appeal Brief and presents no ground of rejection identified as being "new." Claims 1-27 remain on appeal.

Regarding the attempted cancellation of claims 6-10, 16-20, 23 and 24 in an Office Action mailed April 5, 2010, Appellant submits that claims 6-10, 16-20, and 23 remain pending, on appeal, and stand or fall with the corresponding independent claims for which the grounds of rejection are challenged. Claim 24 also remains on appeal, was separately argued, and thus should be treated separately by the Board (that is, it does not stand or fall with claim 1).

Even assuming Appellant acquiesced in any ground of rejection, the Examiner's attempted cancellation of these claims and failure to state the rejections in the Answer does not accord with Patent Office procedures. Specifically, the Manual of Patent Examining Procedure, at Section 1205.02, provides that "[e]ven if the appeal brief withdraws from consideration any claims or issues (i.e., appellant acquiesces to any rejection), the examiner **must continue to make the rejection in the examiner's answer**, unless an amendment obviating the rejection has been entered." (emphasis added). *See also* MPEP § 1207.02 ("Grounds of rejection not specifically withdrawn by the examiner and not set forth in the examiner's answer are usually treated by the Board as having been dropped . . .").

Turning to the substantive issues, Appellant again submits that the rejections of claims 1-5, 11, 12, and 25 as anticipated by Welchel are also made in error. “Because the hallmark of anticipation is prior invention, the prior art reference--in order to anticipate under 35 U.S.C. § 102--must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (emphasis added). This “‘arranged as in the claim’ requirement applies to all claims and refers to the need for an anticipatory reference to show all of the limitations of the claims arranged or combined in the same way as recited in the claims, not merely in a particular order. The test is thus more accurately understood to mean ‘arranged or combined in the same way as in the claim.’” *Id.*

In the Answer, the rejection of claim 1 relies on features of two different passages in Welchel relating to different aspects of the invention (namely, the Figure 1 embodiment for the basic layers, and the embodiment of Figure 3 and col. 7, lines 21-53 for the mere mention of “bicomponent staple fibers”). Nowhere does this reference expressly describe the invention of claim 1, arranged as set forth in this claim, as it completely fails to describe any two layers of bonded, wet-processed mat comprising thermoplastic polymer staple fibers and thermoplastic bicomponent fibers of different fiber formulations. Accordingly, the stated rejection does not meet the “arranged as in the claim” requirement for a proper anticipation rejection.

The same analysis applies to claim 25, which requires “discrete layers.” The Examiner cites to “layer 106,” but according to Welchel, reference numeral 106 refers to a “region” of other layers, not a discrete layer. The same is true for “region 114,” which the Examiner equates to the claimed first layer. Although perhaps convenient in terms of simplifying the rejection process, “[t]he broadest-construction rubric . . . does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention.” *In re Suitco Surface, Inc.*, 2010 U.S. App. LEXIS 7620 (Fed. Cir. Apr. 14, 2010). Accordingly, the exact same invention set forth in claim 25 (that is, an insulator with discrete layers having the claimed fiber formulations) is not disclosed.

With respect to claim 26 specifically, Appellant wishes to note that nowhere in the statement of rejection contained in the final Office Action or the Answer is it explained how Welchel discloses the claimed layers comprised of the recited fibers with contacting faces. Rather, the Examiner simply states that:

Welchel discloses that the first mat layer comprises matrix fibers and that the second mat layer comprises a different fiber formulation which is a mixture of

matrix fibers and absorbent fibers . . . Therefore, each layer relates to a different fiber formulation.

This rejection thus lacks substantial evidentiary support and should be reversed.

Regarding the rejections of claims 1-5, 9-15, 19-22, and 25-27 based on the combination of Oleszczuk and Lickfield as primary references, in further view of Welchel, Appellant emphasizes the dearth of evidence supporting the conclusion that the layers (14) and (16) of Oleszczuk et al. and Lickfield et al. “would be directly bonded to another layer of wet processed mat.” (Examiner’s Answer, page 8). Oleszczuk and Lickfield do not in any of the passages cited disclose that an additional “wet processed mat” layer may be added to the article, let alone **directly bonded to another wet processed mat layer** as required by the claims at issue. Accordingly, the rejection is based on speculation, which cannot sustain a proper rejection. *In re Warner*, 54 C.C.P.A. 1628, 1635 (C.C.P.A. 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. *It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.* To the extent the Patent Office rulings are so supported, there is no basis for resolving doubts against their correctness. Likewise, we may not resolve doubts in favor of the Patent Office determination when there are deficiencies in the record as to the necessary factual bases supporting its legal conclusion of obviousness.”) (emphasis added).

For claim 25, the Answer states that “the claims [*sic* claim] do not distinguish between the first second and third layers.” Respectfully, this is not correct, since claim 25 expressly refers to “discrete” layers. Hence, the claim does expressly distinguish between the claimed layers. “A single mass of wet processed bonded fibrous mat” cannot be considered, under any broadest reasonable interpretation, an article with discrete layers, when such term is construed in light of the Appellant’s specification and the ordinary meaning of the word “discrete.” Notably, the Examiner cites no definition supporting his construction, and points to nothing in the present specification that supports it, either. In other words, nothing establishes that this interpretation is “consistent with the one that those skilled in the art would reach.” *In re Cortright*, 165 F.3d 1353, 1358 (Fed.Cir.1999).

With respect to claim 26, the Examiner’s Answer (like the final Action from which the appeal was taken) does not in any way explain the manner in which the limitations of this claim are met by the three cited references. This is true despite the fact that this claim is rejected at

two different places in the Answer (see pages 7 and 10). Accordingly, the rejection of claim 26 based on obvious cannot possibly qualify as a *prima facie* case.

In rejecting method claim 27 as “obvious,” the Examiner merely states that:

Oleszczuk and Lickfield each disclose that the layers may be thermally bonded It is noted that Welchel also discloses that the thermoplastic bicomponent staple fiber nonwoven layers (105 and 102) are to be directly bonded (45-48).

Respectfully, this statement does not address the steps of: (1) wet processing thermoplastic polymer staple fibers and thermoplastic bicomponent fibers to form a first layer of wet processed mat having a first face; (2) wet processing thermoplastic polymer staple fibers and thermoplastic bicomponent fibers to form a second layer of wet processed mat having a different fiber formulation than said first layer, said second layer having a second face; and (3) applying sufficient heat and pressure to the first and second layers of mat to bond said first layer and said second layer directly together and form the liner/insulator. Accordingly, reversal of the rejections is therefore in order.

As for the maintained rejections of claims 1-5, 11-15, 21-22, and 25-27 as obvious in light of Welchel “in view of anyone of” Holm, Cederblad, or D’Acchioli, the Examiner contends that “appellant fails to teach or suggest unexpected results.” No citation of authority is provided regarding the need of a patent applicant to “teach or suggest” unexpected results in order to obtain a patent. Rather, in stark contrast, the law requires the USPTO produce the factual basis for a rejection under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (citing *In re Warner, supra*). Thus, the one who bears the initial burden of presenting a *prima facie* case of unpatentability is the Examiner, and it is not the Appellant’s burden to “teach or suggest” unexpected results. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In making these rejections, the Answer continues to cite the inapposite decisions of *In re Fout*, 675 F.2d 297, 301 (CCPA 1982), *In re Siebentritt*, 372 F.2d 566, 152 USPQ 618, 54 CCPA 1083, 1085 (CCPA 1967), and *In re Ruff*, 256 F.2d 590, 118 USPQ 343 (CCPA 1958), in support of a *per se* rule that equivalence is synonymous with obviousness. Appellant distinguished these cases in the Appeal Brief, and further notes the precedential decision of *In re Edge*, 359 F.2d 896, 898-899 (C.C.P.A. 1966) (“The examiner and the board appear to hold that the mere existence of ‘functional and mechanical equivalence’ establishes ‘obviousness.’ We think this involves a *non sequitur*. **Expedients which are functionally equivalent to each other are not necessarily obvious in view of one another.** The statutory mandate of 35 U.S.C. 103 is

that the claimed subject matter be unobvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.”) (emphasis added); *see also* MPEP 2144.08 (“Use of *per se* rules by Office personnel is **improper** for determining whether claimed subject matter would have been obvious under 35 U.S.C. 103.”) (emphasis added).

In summary, Appellant has addressed and met every rejection set forth by the Examiner and submits that all of the rejected claims meet the statutory requirements for patentability. Thus, it is respectfully requested that all outstanding rejections of all claims be reversed and that the present application be remanded to the Examiner with instructions for immediate allowance.

Please debit any fee due from Deposit Account 50-0568.

Respectfully submitted,

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June 10, 2010

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